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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,627	02/02/2001	Hideyuki Ariyasu	0152-0551P-SP	7701

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

8

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary

Application No.

09/773,627

Applicant(s)

ARIYASU ET AL.

Examiner

Kevin R Kruer

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1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 25 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the integrated structure could be made by a materially different method. For example, the member © could be extruded or cast rather than molded.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 25 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

1. The rejection of claim 3 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by amendment and/or argument.
2. The rejection of claims 11 and 12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by amendment and/or argument.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. The rejection of claims 1, 5, 9-11, 13, 14, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Koder a et al (US 4,250,661) has been overcome. Applicant incorporated claim 2 into claim 1.

Claim Rejections - 35 USC § 103

5. The rejection of claims 1, 5, 6, 9-11, 13, 14, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koder a et al (US 4,250,661) in view of Sakurai et al (US 4,377,667) has been overcome by the incorporation of claim 2 into claim 1.

6. Claims 1-5, 9-11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koder a et al (US 4,250,661) in view of Blemberg et al (US 5,108,844) for reasons of record.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koder a et al (US 4,250,661) in view of Blemberg et al (US 5,108,844), as applied to claims 1-5, 9-11, 13, 14, 16, and 17 above, and further in view of Sakurai et al (US 4,377,667).

Koder a in view of Blemberg is relied upon as above. Specifically, Koder a teaches that the polyacetal should comprise have a degree of polymerization of 500-3,500 and comprise copolymers of ethylene oxide and polyoxymethylene molecules (col 2, lines 19+). Koder a does not teach that the composition should comprise an aliphatic alcohol chain transfer agent. However, Sakurai discloses that molecular weights of polyacetals can be controlled by utilizing small amounts of water, methanol, and formic acid in the polymerization system. Thus, it would have been obvious to one of ordinary skill in the

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art to include water or methanol in the polymerization system of Koderia in order to control the degree of polymerization.

8. Claims 7, 8, 12, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koderia et al (US 4,250,661) in view of Blemberg et al (US 5,108,844), as applied to claims 1-5, 9-11, 13, 14, 16, and 17 above, and further in view of Matsuzaki et al (US 4,535,127) for reasons of record.

9. Claims 1-4, 10, 11, 13, 16, 17, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-029276 (herein referred to as Polyplastics) in view of Blemberg et al (US 5,108,844) for reasons of record.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-029276 (herein referred to as Polyplastics) in view of Blemberg et al (US 5,108,844) as applied to claims 1-4, 10, 11, 13, 16, 17, 21, and 22 above, and further in view of JP 58-053953A (herein referred to as JSR) for reasons of record.

11. Claims 7, 8, 12, 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-029276 (herein referred to as Polyplastics) in view of Blemberg et al (US 5,108,844) as applied to claims 1-4, 10, 11, 13, 16, 17, 21, and 22 above, and further in view of Matsuzaki et al (US 4,535,127) for reasons of record.

Response to Arguments

Applicant's arguments filed July 9, 2003 have been fully considered but they are not persuasive.

Applicant argues that Koderia in view of Blemberg is directed to a sheet wherein the claims are drawn to an "integrated structure." Applicant, however, has not

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described why they consider an integrated structure to be exclusive of sheets. Merriam Webster's defines "integrate" as "to unite with something else." A laminate sheet would therefore necessarily be "integrated."

Applicant also notes that the contact area between members could be rather small. However, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., small contact area) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Applicant argues that the claimed laminate is made by a different process than the process used to make the laminate of the applied art. Applicant is reminded that a method of making a product does not patentably distinguish that product from the prior art unless it can be shown that the method of making the product inherently results in a materially different product. In the present application, no such showing has been made.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

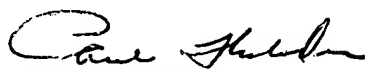
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

KRK

krk


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700